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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/579,965

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Hadi Partovi

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EXAMINER

MIRZA, ADNAN M

ART UNIT

PAPER NUMBER

2445

NOTIFICATION DATE

DELIVERY MODE

06/28/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentprocurement@perkinscoie.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/579,965	PARTOVI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	ADNAN MIRZA	2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 10-13, 15, 16 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-13, 15, 16 and 32-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/26/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 10-13,15,16,32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al (U.S. 6,101,486) and Gilmour et al (U.S. 6,421,669)

3. As per claims 10,34,37 Roberts disclosed a method receiving a request from a first user to add contact information of a second user to the electronic phone book of the first user; wherein the request is detected when the first user accesses a URL, provided by the second user to the first user (col. 2, lines 50-57); one ordinary skill in the art at the time of the invention knows that electronic phonebook is another name for profile database where both have the purpose of storing the user information, Wherein the URL includes a unique identifier for identifying the contact information of the second user; identifying the contact information of the second user data set based on the unique identifier (Roberts, col. 5, lines 15-25).

However Roberts did not disclose in detail, “determining if the request includes a cookie that is associated with the electronic phonebook of the first user; and adding the contact information of the second user to the electronic phone of the first user in response to

determining that the request includes the cookie that is associated with the electronic phonebook”.

In the same field of endeavor Gilmour disclosed, “Subsequently when the user chooses to send the message using the appropriate control on the particular e-mail client, the email address of the knowledge gathering server is email address of the knowledge gathering server is appended to the blind copy list for the message. The profiling system encrypts and encodes the following information into the message header, for transmission to and decoding by the knowledge gathering system (col. 12, lines 4-12). Gilmour also disclosed, “The above described method is advantageous in that a user is not required to remember routinely to update his or her user profile, but is instead periodically notified of terms that are candidates for inclusion within his or her user knowledge profile. Upon notification, the user may select terms for inclusion within the public portion of the user knowledge user profile (col. 20, lines 1-7)”.

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have incorporated Subsequently when the user chooses to send the message using the appropriate control on the particular e-mail client, the email address of the knowledge gathering server is email address of the knowledge gathering server is appended to the blind copy list for the message. The profiling system encrypts and encodes the following information into the message header, for transmission to and decoding by the knowledge gathering system. The above described method is

advantageous in that a user is not required to remember routinely to update his or her user profile, but is instead periodically notified of terms that are candidates for inclusion within his or her user knowledge profile. Upon notification, the user may select terms for inclusion within the public portion of the user knowledge user profile in the method and system of Roberts as taught by Gilmour to provide efficiently enable applications to share functionality, preferably from a single interface and that provide the flexibility scalability and user-friendliness and make it Financially valuable

.

3. As per claim 11 Roberts- Gilmour disclosed wherein the second user identifier is a parameter specified in the URL (Roberts, col. 2, lines 53-63).

4. As per claim 12 Roberts- Gilmour disclosed wherein the contact information comprises a name and a telephone number (Roberts, col. 2, lines 53-63).

5. As per claim 13 Roberts- Gilmour disclosed wherein the data set is a vCard (Roberts, col. 2, lines 53-63).

6. As per claim 15 Roberts- Gilmour disclosed wherein the second user identifier comprises a user-ID corresponding to the second user (Roberts, col. 5, lines 15-25).

7. As per claim 16 Roberts- Gilmour disclosed wherein the second user identifier enterprises a telephone identifying information corresponding to the second user (Roberts, col. 5, lines 15-25).

8. As per claims 32,35 Roberts- Gilmour disclosed further comprising: requesting that the first user present authenticating information when the single request does not include a cookie that is associated with the electronic phonebook of the first user; identifying the electronic phonebook based on the authenticating information and adding the contact information of the second user to the electronic phonebook of the first user (Roberts, col. 5, lines 16-24).

9. As per claims 33,36 Roberts- Gilmour disclosed further comprising: creating a new electronic phonebook when the request does not include a cookie that is associated with the electronic phonebook of the first user; and adding the contact information of the second user to the new electronic phonebook (Gilmour, col. 19, lines 40-59).

### ***Response to Arguments***

10. Applicant's arguments filed 08/21/2008 have been fully considered but they are not persuasive. Response to applicant's arguments is as follows.

A. Applicant argued that prior art failed to establish Prima facie obviousness.

As to applicant's argument In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, in the method and system of Roberts as taught by Gilmour to provide efficiently enable applications to share functionality, preferably from a single interface and that provide the flexibility scalability and user-friendliness and make it Financially valuable

B. Applicant argued that prior art did not disclose, "determining if the request includes a cookie that is associated with the first user profile; adding the data set of the second user profile to the first user profile in response to determining that the request includes a cookie that is associated with the first user profile".

As to applicant's argument Gilmour disclosed, "Subsequently when the user chooses to send the message using the appropriate control on the particular e-mail

client, the email address of the knowledge gathering server is email address of the knowledge gathering server is appended to the blind copy list for the message. The profiling system encrypts and encodes the following information into the message header, for transmission to and decoding by the knowledge gathering system (col. 12, lines 4-12). Gilmour also disclosed, "The above described method is advantageous in that a user is not required to remember routinely to update his or her user profile, but is instead periodically notified of terms that are candidates for inclusion within his or her user knowledge profile. Upon notification, the user may select terms for inclusion within the public portion of the user knowledge user profile (col. 20, lines 1-7)".

C. Applicant argued that prior art did not disclose, "receiving a request from a first user to add contact information of a second user to the electronic phonebook of the first user".

As to applicant's argument Roberts disclosed,

10 Another method, consistent with this invention, for cus-  
tomizing a website in accordance with user profile informa-  
tion includes several steps. Initially, a plurality of user  
identification data is received and used to create a user  
profile. The user profile is retrieved from a profile database  
15 when a call from the user is received. Thereafter, the user  
profile is compared to marketing material maintained by the  
company and a dynamic content message is generated. A  
webpage is configured for display by inserting the dynamic  
" content message into the webpage. (col. 2, lines 50-57).

D. Applicant argued that prior art did not disclose, "the request is detected when the first user accesses a URL provided by the second user to the first user".



As to applicant's argument Roberts disclosed, "

10 Another method, consistent with this invention, for cus-  
tomizing a website in accordance with user profile informa-  
tion includes several steps. Initially, a plurality of user  
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15 when a call from the user is received. Thereafter, the user  
profile is compared to marketing material maintained by the  
company and a dynamic content message is generated. A  
webpage is configured for display by inserting the dynamic  
content message into the webpage.

(col. 2, lines 50-57).

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Adnan Mirza whose telephone number is (571)-272-3885.

13. The examiner can normally be reached on Monday to Friday during normal business hours. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SRIVASTAVA VIVEK can be reached on (571)-272-7304. The fax for this group is (703)-746-7239. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866)-217-9197 (toll-free).

/A. M./

Examiner, Art Unit 2445

/VIVEK SRIVASTAVA/

Supervisory Patent Examiner, Art Unit 2445